

REMARKS

Claims 1-15 are pending in this case. Based upon the following remarks, it is respectfully submitted that these claims are allowable.

A. §103 Rejection of Claims 1-15

Claims 1-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nishida et al., U.S. Patent No. 4,541,091 ("*Nishida et al.*"). This rejection is respectfully traversed and it is submitted that these claims recite subject matter which is patentable over *Nishida et al.*

Regarding independent claims 1 and 12, the Examiner contends that *Nishida et al.* discloses the presently claimed invention with the exception of the storage of the "digital transmission signal" as recited. However, according to the Examiner, it would have been obvious to one of ordinary skill in the art to store the "digital transmission signal" as recited "for reference in [a] future error correction procedure, since it has been held that rearranging parts of an invention involves only routine skill in the art." It is respectfully submitted that this is not applicable in this case.

By stating that it would have been obvious to one of ordinary skill in the art to store the "digital transmission signal" as recited "for reference in [a] future error correction procedure" the Examiner appears to consider an "error correction procedure" to be the basis or reason for practicing the presently claimed invention. However, that is not true. The presently claimed invention does not perform error correction, but instead operates under the assumption, i.e., based upon a known, controlled production testing environment, that the data being captured is good data with no error correction being necessary and, therefore, no provision made for any error correction. More particularly, a known good signal from a trusted unit similar to the device under test (DUT) is captured and made available for use (in conformance with the claim recitations) for production testing of DUTs in a

simple, reliable and inexpensive manner, e.g., without a need for complex test equipment capable of independently duplicating the necessary test signals as well as the significant operating software and operator training often associated with such test equipment. See, e.g., the present disclosure at paragraphs [00015]-[00024]. Hence, without the motivation of providing or performing “error correction”, and with no other motivation cited or seen, the cited axiom regarding the “rearranging of parts” is simply not applicable.

B. §102 Rejection of Claims 1 & 12

Claims 1 and 12 were rejected under 35 U.S.C. §102(e) as being anticipated by Lovell et al., U.S. Patent No. 6,831,945 (“*Lovell et al.*”). However, it is noted that immediately preceding this rejection in this same section was a discussion of 35 U.S.C. §103(a), and further that *Lovell et al.* was expressly described later in this section as lacking at least one of the presently recited elements with an assertion that such element would have nonetheless been obvious to one of ordinary skill in the art. Therefore, this rejection is treated herein as a rejection under 35 U.S.C. §103(a). This rejection is respectfully traversed and it is submitted that these claims recite subject matter which is patentable over *Lovell et al.*

Regarding independent claims 1 and 12, the Examiner contends that *Lovell et al.* discloses the presently claimed invention with the exception of the location (or order) of the “modulator” (or “modulation”) as recited. However, according to the Examiner, it would have been obvious to one of ordinary skill in the art to “change the location of the modulator, since it has been held that rearranging parts of an invention involves only routine skill in the art.” It is respectfully submitted that this is not applicable in this case.

As discussed in Part A hereinabove, the presently claimed invention captures a known good signal from a trusted unit similar to the device under test (DUT) and makes such signal available for use (in conformance with the claim 11602.00.0012

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recitations) in production testing of DUTs in a simple, reliable and inexpensive manner, e.g., without a need for complex test equipment capable of independently duplicating the necessary test signals as well as the significant operating software and operator training often associated with such test equipment. See, e.g., the present disclosure at paragraphs [00015]-[00024]. The Examiner has not cited and it is not seen where or how the disclosure of *Lovell et al.* discloses or suggests such a purpose or effect or anything other reason which might provide a motivation consistent with the express purpose and effect of the presently claimed invention.

C. Conclusion

Claims 1-15 remain pending in this case. Based upon the foregoing remarks, it is respectfully submitted that these claims are allowable, and reconsideration and early allowance of these claims are requested.

Respectfully submitted,

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